

REMARKS

1. Objection to claim 14.

(w/1) Claim 14 has been objected to for being dependent upon a canceled claim.

Applicants have amended claim 14 to be dependent upon independent claim 1.

Removal of the objection is respectfully requested.

2. Acknowledgement of priority claim

OK The instant application was submitted as a U.S. National Phase application under Chapter II of the PCT. As such, the PTO should have received copies of the certified copies of the priority documents. Confirmation of such receipt is respectfully requested. The PTO's assistance in this matter is appreciated.

3. Rejection of claims 1-4, 6-11, 13-16, and 18 under 35 U.S.C. §103(a) as obvious over Muthiah et al., EP 0 844 286 (hereafter "Muthiah" or "EP '286") in view of Craun et al., U.S. 6,184,281, hereafter "Craun" or "US '281".

The prior rejection has been maintained. The basis of the continuing rejection is understood to be as follows:

Relevant Craun
Craun teaches a coating composition suitable for coating plastic substrates where the coatings are easily removable (abstract) where the coatings can be powder coatings (column 2, line 30).It would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of EP '286 because Craun teaches the removable coatings are recyclable (abstract) and are therefore environmentally safe.

Office Action of 6/2/03, pages 3 & 4.

Applicants and the Undersigned greatly appreciate the detailed basis for the continuing rejection, particularly the PTO's reasoned reply to the previously submitted amendments and remarks. However, Applicants must continue to respectfully disagree with the PTO's position and continue to submit that the pending claims are patentable over the art of record.

Applicants' amended independent claim 1 sets forth a particular laminatable film. The claimed laminatable film must have at least one support layer that is coated with one or more coating layers. The support layer must have a film thickness of between 10 and 1000 μm and must be selected from a group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film. At least one of the one or more coating layers on the support layer must be a thermally curable powder coating or a thermally curable powder coating dispersion. Finally, the laminatable film of the invention must be rollable, that is, it must be able to be rolled up. *Curp*

Curp A. Amended independent claim 1 is patentable because the cited combination of art fails to provide a *prima facie* of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *MPEP 2143*

The combination of Muthiah and Craun fails to provide a *prima facie* case of obviousness with respect to the claimed invention for two reasons. First, the cited combination fails to disclose or suggest a motive to modify the disclosures of the cited references so as to obtain the invention of Applicants' claim 1. Second, the cited combination fails to provide all of the required elements of the invention of Applicants' amended claim 1.

1. The cited combination of references fails to provide a *prima facie* case of obviousness because it fails to provide any motivation to modify or combine the references so as to obtain Applicants' claimed invention.

The motivation to modify the inventions of the cited references in order to obtain the claimed invention must come from the references themselves. The mere fact that references can be combined or modified does not render the resultant combination

obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990)

WID
Craun The PTO's position is that "[i]t would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of EP '286 because Craun teaches the removable coatings are recyclable (abstract) and are therefore environmentally safe". *Office Action of 6/2/03, pages 3 & 4.* → *Col 9*

Applicants must respectfully disagree with the PTO's interpretation of Craun. Craun does not teach that the removable coatings are recyclable. Rather, the *plastic bottles* to which the *strippable coating* is applied to are recyclable. For example, the abstract of the '281 patent relied upon by the PTO actually reads "[s]trippable aqueous a ionomeric coating composition suitable for coating plastic substrates where the coatings are easily removable by caustic treatment of the plastic *during recycling of the plastic*. '281 patent, Abstract, *emphasis added*.

Several additional statements in Craun support the position that it is only the *plastic bottles* to which the *strippable coatings* are applied to and removed from that are recyclable. *part of inv*

For example, the background section of Craun states '[t]he ionomeric coatings of this invention can be tinted to provide color to the plastic bottle, but leave the PET uncolored, and thus provide a greater value for recycling.

The first paragraph of the Specification states "[t]his invention pertains to aqueous coatings based on an ionomeric polymeric binder suitable for coating plastics, and particularly ionomeric coatings to be applied to *plastic containers subject to recycling* where the ionomeric coatings are removable from plastic containers during a caustic recycling process. '281 patent, col. 1, lines 5-10, *emphasis added*.

Finally, Craun makes it clear that after recycling, 'new' *strippable coatings* must be applied to recycled bottles. Indeed, new coatings are required because the process of removing the *strippable coatings* results in the *disintegration* of the *strippable coating film*. In column 6, lines 56-64, Craun states:

In the recycling of plastic bottles or scrap plastics, the old plastics are treated with heated caustic water at temperatures typically below 160 degree. It has been found that under caustic treatment, the clustered ionomeric coatings of this invention break down the crosslinks and

thereby essentially disintegrates the coating enabling easy separation from the recycled substrate. Caustic cleaned bottles can then be reused by applying a new ionomeric coating of this invention to the recycled cleaned plastic bottle.

It can thus be seen that there is no motivation to include the removable coating (film) of Craun to at least one powder coating of layer of EP '286. No 'film' exists after the caustic stripping process of Craun. To argue otherwise is to ignore the required operating mechanism of the '281 patent because Craun clearly teaches that the strippable coating is removed via disintegration of the coating.

JWL

The PTO's argument that this disintegrated coating can function as the support layer of Applicants' claimed invention necessarily assumes that the removed coating exists as a continuous non-disintegrated film. However, a continuous film requires the maintenance of the crosslinking network. Craun requires the disintegration of these networks in order to effect the removal of the strippable coating from the recycled plastic bottle.

The PTO's position contravenes the basic operating principle of the '281 reference. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 USPQ 349 (CCPA 1959); MPEP 2143.01

The PTO has suggested that the environmental safety of the strippable coatings of Craun is sufficient motivation to do what Applicants' have done. However, the environmental safety of the strippable coatings of Craun fails to provide any motivation to combine the removed coating of Craun with the powder coating of EP '286. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Fritch*, 23 PQ2d 1780 (CAFC 1992).

It is respectfully submitted that Applicants' claimed invention could only result from the cited combination of references with the benefit of hindsight and Applicants' teachings. The CAFC has stated "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record

convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. *W.L. Gore* 220 U.S.P.Q. 303, 312-313. (Fed. Cir. 1983).

Reconsideration and removal of the rejection is respectfully requested on the grounds that the cited combination of references fail to provide a motivation to modify the references so as to obtain Applicants' claimed invention.

2. The cited combination of references fails to provide a prima facie case of obviousness because it fails to disclose or suggest all of the claim limitations required by amended independent claim 1.

A prima facie case of obviousness requires that the prior art reference (or references when combined) teach or suggest all the claim limitations. *MPEP 2143* This standard has not been met with the cited combination of references.

As previously noted, the claimed laminatable film must have at least one particular support layer that is coated with at least one thermally curable powder coating or dispersion. It is an aspect of the claimed invention that the support layer be characterized by two different limitations. First, the support layer must have a film thickness of between 10 and 1000 μm . Second, the support layer must be selected from a group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film. Finally, the laminatable film of the invention must be rollable, that is, it must be able to be rolled up.

The cited combination of references fails to disclose several of these required limitations and thus fails to disclose Applicants' claimed invention as a whole.

For example, the cited combination of references fails to disclose a support layer that must be selected from a group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film. *abstract*

The PTO has suggested that this argument is irrelevant because claim 1 consists of the 'open' transition phrase, comprising, which the PTO says does not merit the disclosure of only those support layer materials that are particularly required within a given claim. Applicants had previously argued that the cited combination fails to provide any motivation to restrict the support layer to the particularly recited Markush

group containing three elements. The PTO has also found this argument nonpersuasive on the grounds that the argument lacks support.

AKM

As a preliminary matter, Applicants note that the use of an open transition phrase does not relieve the PTO from its burden of disclosing the required elements of a claimed invention. It is an aspect of Applicants' particular invention that they have chosen to limit or 'close' the support layer element. This aspect of Applicants' invention may not be ignored. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976).

With respect to the PTO's statement that the previously submitted arguments lack support, Applicants note that the PTO has the burden of proving a *prima facie* case of obviousness. *In re Bell*, 26 U.S.P.Q.2nd 1529, 1530 (Fed. Cir. 1993). This includes showing how all of the required claim limitations are disclosed or taught by the cited combination of references. Applicants do not have the burden of providing support.

In this case, the PTO has not cited any passage or portion of either reference for the disclosure of a support layer selected from a group consisting of these three elements. When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference. *In re Yates*, 211 U.S.P.Q. 1149, 1151 (C.C.P.A. 1981).

Nor has the PTO established why one of skill in the art would be motivated to particularly select only these three types of support layers for use in the claimed invention. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q. 1673 (CAFC 1988).

EP '286 discloses a variety of substrates and is silent as to the importance of flexibility in such substrates. One of skill in the art would not find any motivation to select only those thermoplastic films, coated thermoplastic films, and self-supporting

j. note

paint films. Applicants also note that if there were such disclosure in EP '286, the basis of rejection would be different.

Craun fails to rectify the failings of EP '286. As noted above, the removable film of Craun disintegrates upon removal and is thus incapable of serving as a self-supporting paint film in the support layer of the claimed invention.

Thus, the cited combination of references fails to disclose a laminatable film having a support layer selected from the group consisting of thermoplastic films, coated thermoplastic films, and self-supporting paint films.

Second, the cited combination of references fails to disclose a support layer having a film thickness in the range required by Applicants' claimed invention.

The PTO has responded with argument that this aspect of Applicants' claimed invention is mere optimization and the result of routine experimentation. In particular, the PTO appears to be indicating that some showing of unexpected results is necessary.

Address from:
However, the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an applicant to prove conclusively that the Patent Office is wrong. *In re Soli*, 137 USPQ 797 (CCPA 1963) The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular structural modification is "well known" and thus obvious. Subjective opinions are of little weight against contrary evidence. *In re Wagner et al.* 152 USPQ 552 (CCPA 1967)

DTS
In this case, nothing in the references suggests either the particularly required support layer or the specific film build thickness of Applicants' amended independent claim 1. Thus, there is no support for the PTO's contention that this element could be obtained through 'routine optimization'. Moreover, it is noted that routine optimization of film build thickness seems unlikely when neither reference discloses or suggests the particularly required support layer discussed immediately above.

In addition, Applicants note that the PTO's contention of 'routine optimization' appears to be nothing more than an application of the prohibited 'obvious to try' standard. "Obvious to try" is not a valid test of patentability. *In re Mercier*, 185

U.S.P.Q. 774 (C.C.P.A. 1975). Patentability determinations based on that as a test are contrary to statute. *In re Antonie*, 195 U.S.P.Q. 6 (CCPA 1977).

Thus, it is respectfully submitted that the cited combination of references fails to disclose or suggest the specifically required film build range of Applicants' particularly required support layer.

Finally, the cited combination fails to disclose a laminatable film that can be rolled up.

The PTO has argued that this limitation "...constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to perform said feature." *Office Action of 6/2/03, page 3.*

D 13 → Applicants must respectfully disagree and submit that there is no basis in law for discounting a required performance characteristic of a composition. The laminatable film of the invention must be rollable. This is a required performance limitation that may not be discounted. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

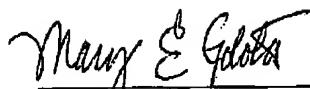
Nothing in the cited combination of references suggests or discloses a laminatable film that is rollable.

Reconsideration and removal of the rejection is respectfully requested. The cited combination of references fails to provide a prima facie case of obviousness because the cited combination fails to disclose all of the required elements of the claimed invention of amended independent claim 1. Taken as whole, the claimed invention is thus nonobvious over the disclosures of the cited art.

CONCLUSION

It therefore respectfully suggested that the cited combination fails to provide a prima facie case of obviousness with respect to amended independent claim 1 and the remaining claims dependent thereon. Reconsideration and removal of the rejection is respectfully requested.

Respectfully Submitted,



Mary E. Golota

July 7, 2003

Registration No. 36,814

Cantor Colburn LLC

248-524-2300

FAX RECEIVED
JUL 15 2003
TC 1700**CORRESPONDENCE ADDRESS & CUSTOMER NUMBER:**

BASF Corporation
26701 Telegraph Road
Southfield, Michigan 48034-2442
Customer No. 26922